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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/521,479

01/18/2005

Teemu Makinen

39700-582N01US/NC16997US

6987

64046

7590

05/10/2010

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EXAMINER

FOUD, HICHAM B

ART UNIT

PAPER NUMBER

2467

MAIL DATE

DELIVERY MODE

05/10/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/521,479	<b>Applicant(s)</b> MAKINEN ET AL.	
	<b>Examiner</b> HICHAM B. FOUD	<b>Art Unit</b> 2467	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

***DETAILED ACTION***

***Response to Amendment***

1. The amendment filed on 02/05/2010 has been entered and considered.

Claims 1, 4-8 and 11-13 are pending in this application.

Claims 2-3, 9-10 and 14-15 have been canceled.

Claims 1, 4-8 and 11-13 remain rejected as discussed below.

***Claim Objections***

2. Claims 4-6 and 11-12 are objected to because of the following informalities:

The claims recite the term "serving system node" which is supposed to be --new serving system node-- based on the amended claims 1 and 8.

Appropriate correction is required.

***Drawings***

3. Figures 2-3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

4. The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention. Applicant is required to furnish a drawing

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under 37 CFR 1.81(c). No new matter may be introduced in the required drawing.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d).

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 4-8 and 11-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite because it recites that the serving system informs the interception system of new the serving node (see lines 8-10), then in lines 15-17 recites that a gateway informs the interception system of the new serving node again. Therefore, it is not known/clear why the interception system is being informed twice from different nodes. Thus, it is not known the metes and the bounds of the claimed invention. Similar issues occur in claim 8.

Claims 4-7 and 11-13 are rejected because of their dependency on the rejected claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 5, 6, 8, 11-12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse et al (US 6,104,929) hereinafter is referred to as Josse in view of Sjoblom (US 7,310,331).

For claim 1, Josse discloses a method comprising the steps of: detecting a serving system node change request from a target (MS) towards a new serving system node which is currently not serving the target (see Figure 4A step 4-1 and column 12 lines 9-19; the sending of a routing area update request message), processing the serving system node change request at the serving system node currently not serving the target, wherein the processing comprises the inclusion, to the serving system node change request, of a serving system address of the new serving system node currently not serving the target (see Figure 4A step 4-2a and column 12 lines 22-27; the inclusion of the new SGSN address); forwarding the processed serving system node change request to an old serving system node currently serving the target (see Figure 4A step 4-2a and column 12 lines 22-27; wherein the request is sent to the old SGSN); detecting whether there is at least one currently active communication context for the target at the new serving system node which is currently not serving the target (see at least Figure 4A steps 4-4a to 4-4b and column 12 lines 64-67; PDP context operations); generating, when there is at least one currently active communication context, a communication context update request including the serving system address of the new serving system node currently not serving the target (see Figure 4A step 4-6 and column 13 lines 33-38; wherein the use of the update SGSN address request message that contains the

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address of the new SGSN), and forwarding the generated communication context update request to a gateway serving system node of the serving system currently serving the target (see Figure 4A step 4-6 and column 13 lines 33-38; wherein the update SGSN address request message is sent from the new SGSN to the GGSN). Josse discloses all the subject matter with the exception of wherein the old serving system node (SGSN)/GGSN inform a lawful interception system of the new serving system serving an intercepted target (MS). However, Sjoblom discloses a method wherein the serving system/GGSN informs the lawful interception system of the serving system serving an intercepted target (MS) (see Figure 1 and column 1 line 27 to column 2 line 48; wherein GSN "element 3" is connected to the lawful interception system LEA "element 1" and sending information through the interfaces X0\_1, X0\_2 and X0\_3; such as IRI which is the interception related information and see at least col.6 lines 20-24). Thus, it would have been obvious to the one skill in the art at the time of the invention to have a connectable lawful interception system to the GSN system as taught by Sjoblom into the method of Josse for the purpose of interception of information and in case of SGSN handover continue performing a lawful interception.

For claims 5 and 11, Josse discloses a method wherein said serving system address of the serving system node represents information about the serving system to which said serving node belongs (see column 12 lines 35-38; the new address represents information, to which said new serving node belongs, that is required to allow the old SGSN to forward packets to the new SGSN until the old MM context is cancelled).

For claims 6 and 12, Josse discloses a method, wherein said information about the serving system to which said serving node belongs comprises at least one of the following information items: serving node number, serving node routing area identifier, and serving node address (see column 12 lines 26-28; the new address, RAI).

Claim 8 is rejected for same reasons as claim 1, because it would have been obvious to the one skill in the art at the time of the invention to implement a method into an apparatus for the purpose of making the devices to function as directed by the method.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Josse in view of Sjoblom and further in view of Miettinen et al (US 6,754,834) hereinafter is referred to as Miettinen.

For claim 4, Sjoblom further discloses that GSN node detects and transmits IRI (interception related information) to the lawful interception system, wherein the GSN node can be either SGSN or GGSN (see Sjoblom Fig. 3, column 6 lines 20-25 and column 7 lines 14-16). Josse in view of Sjoblom discloses all the subject matter with the exception of explicitly disclosing wherein said gateway serving system node currently serving the target informs the interception system of the new serving system address of the serving system node. However, Miettinen discloses that the IRI may include location information that is related to roaming since the location information changes according to the location (see Miettinen column 6 lines 27-35). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the interception method as described in Miettinen into the method of Josse in view of Sjoblom to include

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the address of the new SGSN in the IRI sent by either SGSN (old or new) or GGSN to the interception system for the purpose of performing a lawful interception that intercepts the target even when the target is roaming in different cells.

7. Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josse in view of Sjoblom and further in view of Neumann (US 6,792,270).

For claims 7 and 13, Josse in view of Sjoblom discloses all the subject matter with the exception of explicitly disclosing wherein said serving node routing area identifier comprises information items representative of a mobile country code, mobile network code, location area code, and routing area code. However, Neumann discloses a method wherein said serving node routing area identifier contains information items representative of a mobile country code MCC, mobile network code MNC, location area code LAC, and routing area code RAC (see column 5 lines 26-29). Thus, it would have been obvious to the one skill in the art at the time of the invention to use the component of the RAI as disclosed in the invention of Neumann into the method of Josse in view of Sjoblom for the purpose of clearly identifying a routing area worldwide.

### **Response to Argument**

8. Applicant's arguments filed have been fully considered but they are not persuasive:

In regard of the argument in page 7 of the Remarks concerning the drawings, the examiner disagrees with the applicant because it is admitted by the applicant that



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Figures 2 and 3 are taken from 3GPP TS 23.060 (see specification page 11 line 28 and page 18 line 11). Moreover for at least Fig.2, the examiner is submitting as a proof the 3GPP TS 23.060 that shows in page 58, Fig.33 same information as shown in Figure 2 of the instant application and clearly demonstrate that Fig.2 and all of its disclosure is PRIOR ART. Thus, the Figures 2-3 are prior art and must be labeled as prior art.

Moreover, the applicant lacks argument in regard of the Drawing (The subject matter of this application admits of illustration by a drawing to facilitate understanding of the invention) and 112 2<sup>nd</sup> rejection. Furthermore, the applicant is arguing Fig.2 and messages 2 and 6 (see Remarks page 9). However, the examiner disagrees because Fig.2 is clearly shown in 3GPP 23.060 is PRIOR ART and also Josse discloses both messages which are shown in Fig.4A (4-2 and 4-4). Thus, Josse clearly teaches the argued subject matter. In addition and in response to applicant's arguments in pages 10-13 of the Remarks against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Furthermore, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992) (see the rejection above).

Moreover, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references.

Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Also, in page 12 of the Remarks, the applicant is arguing that Sjoblom discloses a single GSN node which cannot operate as SGSN and GGSN.

However, the examiner disagrees because the Examiner is using the same Figure used by the applicant (Fig.1) to reject the claimed subject matter. Moreover, Sjoblom discloses that the GSN node can be a representation of SGSN or GGSN (see at least col.6 lines 20-24). Thus, Sjoblom discloses the argued subject matter.

### ***Conclusion***

**9. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**10. Examiner's Note:** Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner. In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

When responding to this office action, applicants are advised to clearly point out the patentable novelty which they think the claims present in view of the state of the art disclosed by the references cited or the objections made. Applicants must also show how the amendments avoid such references or objections. See 37C.F.R 1.111(c). In addition, applicants are advised to provide the examiner with the line numbers and pages numbers in the application and/or references cited to assist examiner in locating the appropriate paragraphs.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HICHAM B. FOUAD whose telephone number is (571)270-1463. The examiner can normally be reached on Monday - Friday 10-6 EST.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj, Kumar can be reached on 571-272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. B. F./  
Examiner, Art Unit 2467

/Hong Cho/  
Primary Examiner, Art Unit 2467